



PATENT

Attorney Docket: 746829-5

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#3

In re Patent Application of)
Robert S. Oscar et al.)
Serial No. 09/811,769)
Filed: March 20, 2001)
For: PHARMACY BENEFITS)
MANAGEMENT METHOD AND)
APPARATUS)

**RESPONSE TO NOTICE TO FILE MISSING PARTS
OF APPLICATION - FILING DATE GRANTED**

Honorable Commissioner for Patents
Washington, D.C. 20231
Box MISSING PARTS

Sir:

In response to the Notice to File Missing Parts of Non-Provisional Application filed under 37 CFR 1.53(b) filing date granted dated April 24, 2001, submitted herewith are the following documents:

- [X] an executed Declaration and Power of Attorney;
- [X] a copy of the Notice to File Missing Parts of Application;
- [X] 24 Sheets of Substitute Drawings (Figs. 1-23) in compliance with 37 CFR 1.84;
- [X] Fees:
 - \$710.00 Statutory Basic Filing Fee
 - \$130.00 Surcharge, and
 - \$1,144.00 Additional claims (48 total, 11 independent).


The above fees are covered by the attached check in the amount of \$1,984.00. Should there be any additional fees required for proper filing of the attached documents, please

PATENT

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charge Deposit Account No. 19-2380. Prompt issuance of a filing receipt is respectfully requested.

Respectfully submitted,



Marc S. Kaufman
Reg. No. 35,212

NIXON PEABODY LLP
8180 Greensboro Drive
Suite 800
McLean, Virginia 22102
Telephone: (703) 790-9110
Facsimile: (703) 883-0370

Please type a plus sign (+) inside this box → [+]

PTO/SB/21 (08-00)

Approved for use through 10/31/2002. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

Application Number

09/811,769

Filing Date

March 20, 2001

First Named Inventor

Robert S. Oscar et al.

Group Art Unit

Examiner Name

Attorney Docket Number

746829-5

ENCLOSURES (check all that apply)

☒ Fee Transmittal Form

☒ Fee Attached

☒ Preliminary Amendment

☐ After Final

☐ Affidavits/declaration(s)

☐ Extension of Time Request

☐ Express Abandonment Request

☒ Information Disclosure Statement

☐ Certified Copy of Priority Document(s)

☐ Response to Missing Parts/
Incomplete Application

☒ Response to Missing Parts
under 37 CFR 1.52 or 1.53

☒ Assignment Papers
(for an Application)

☒ Drawing(s)

☐ Licensing-related Papers

☐ Petition

☐ Petition to Convert to a
Provisional Application

☐ Power of Attorney, Revocation
Change of Correspondence
Address

☐ Terminal Disclaimer

☐ Request for Refund

☐ CD, Number of CD(s) _____

☐ After Allowance Communication to Group

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm
or

Individual name

Marc S. Kaufman

Nixon Peabody LLP
8180 Greensboro Drive
Suite 800
McLean, VA 22012

Signature

Date

June 20, 2001

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on this date:

Type or printed name

Signature

Date

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FEE TRANSMITTAL FOR FY 2001 <i>Patent fees are subject to annual revision.</i>		Complete if Known	
		Application Number	09/811,769
		Filing Date	March 20, 2001
		First Named Inventor	Robert S. Oscar et al.
		Examiner Name	
		Group Art Unit	
TOTAL AMOUNT OF PAYMENT (\$2,024.00)		Attorney Docket No.	786829-5

METHOD OF PAYMENT		FEE CALCULATION (continued)																																																																																																																																																																																											
1. <input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge indicated fees and credit any overpayments to: Deposit Account Number: 19-2380 Deposit Account Name: Nixon Peabody LLP <input checked="" type="checkbox"/> Charge Any Additional Fee Required Under 37 CFR 1.16 and 1.17 <input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27		3. ADDITIONAL FEES <table border="1"><thead><tr><th>Large Entity Fee Code</th><th>Large Entity Fee (\$)</th><th>Small Entity Fee Code</th><th>Small Entity Fee (\$)</th><th>Fee Description</th><th>Fee Paid</th></tr></thead><tbody><tr><td>105</td><td>130</td><td>205</td><td>65</td><td>Surcharge - late filing fee or oath</td><td>130.00</td></tr><tr><td>127</td><td>50</td><td>227</td><td>25</td><td>Surcharge - late provisional filing fee or cover sheet</td><td></td></tr><tr><td>139</td><td>130</td><td>139</td><td>130</td><td>Non-English transaction</td><td></td></tr><tr><td>147</td><td>2,520</td><td>147</td><td>2,520</td><td>For filing a request for <i>ex parte</i> reexamination</td><td></td></tr><tr><td>112</td><td>920*</td><td>112</td><td>920*</td><td>Requesting publication of SIR prior to Examiner action</td><td></td></tr><tr><td>113</td><td>1,840*</td><td>113</td><td>1,840*</td><td>Requesting publication of SIR after Examiner action</td><td></td></tr><tr><td>115</td><td>110</td><td>215</td><td>55</td><td>Extension for reply within first month</td><td></td></tr><tr><td>116</td><td>390</td><td>216</td><td>195</td><td>Extension for reply within second month</td><td></td></tr><tr><td>117</td><td>890</td><td>217</td><td>445</td><td>Extension for reply within third month</td><td></td></tr><tr><td>118</td><td>1,390</td><td>218</td><td>695</td><td>Extension for reply within fourth month</td><td></td></tr><tr><td>128</td><td>1,890</td><td>228</td><td>945</td><td>Extension for reply within fifth month</td><td></td></tr><tr><td>119</td><td>310</td><td>219</td><td>155</td><td>Notice of Appeal</td><td></td></tr><tr><td>120</td><td>310</td><td>220</td><td>155</td><td>Filing a brief in support of an appeal</td><td></td></tr><tr><td>121</td><td>270</td><td>221</td><td>135</td><td>Request for oral hearing</td><td></td></tr><tr><td>138</td><td>1,510</td><td>138</td><td>1,510</td><td>Petition to institute a public use proceeding</td><td></td></tr><tr><td>140</td><td>110</td><td>240</td><td>55</td><td>Petition to revive - unavoidable</td><td></td></tr><tr><td>141</td><td>1,240</td><td>241</td><td>620</td><td>Petition to revive - unintentional</td><td></td></tr><tr><td>142</td><td>1,240</td><td>242</td><td>620</td><td>Utility issue fee (or reissue)</td><td></td></tr><tr><td>143</td><td>440</td><td>243</td><td>220</td><td>Design issue fee</td><td></td></tr><tr><td>144</td><td>600</td><td>244</td><td>300</td><td>Plant issue fee</td><td></td></tr><tr><td>122</td><td>130</td><td>122</td><td>130</td><td>Petitions to the Commissioner</td><td></td></tr><tr><td>123</td><td>50</td><td>123</td><td>50</td><td>Petitions related to provisional applications</td><td></td></tr><tr><td>126</td><td>180</td><td>126</td><td>180</td><td>Submission of Information Disclosure Stmt</td><td></td></tr><tr><td>581</td><td>40</td><td>581</td><td>40</td><td>Recording each patent assignment per property (times number of properties)</td><td>40.00</td></tr><tr><td>146</td><td>710</td><td>246</td><td>355</td><td>Filing a submission after final rejection (37 CFR § 1.129(a))</td><td></td></tr><tr><td>149</td><td>710</td><td>249</td><td>355</td><td>For each additional invention to be examined (37 CFR § 1.29(b))</td><td></td></tr><tr><td>179</td><td>710</td><td>249</td><td>355</td><td>Request for Continued Examination (RCE)</td><td></td></tr><tr><td>169</td><td>900</td><td>169</td><td>900</td><td>Request for expedited examination of a design application</td><td></td></tr><tr><td colspan="6">Other fee (specify) _____</td></tr><tr><td colspan="5">* Reduced by Basic Filing Fee Paid</td><td>SUBTOTAL (3) (\$170.00)</td></tr></tbody></table>		Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description	Fee Paid	105	130	205	65	Surcharge - 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2. EXTRA CLAIM FEES Total Claims: 48 -20** = 28 X 18 = 504.00 Independent Claims: 11 -3** = 8 X 80.00 = 640.00 Multiple Dependent: _____ = _____ <table border="1"><thead><tr><th>Large Entity Fee Code</th><th>Large Entity Fee (\$)</th><th>Small Entity Fee Code</th><th>Small Entity Fee (\$)</th><th>Fee Description</th></tr></thead><tbody><tr><td>103</td><td>18</td><td>203</td><td>9</td><td>Claims in excess of 20</td></tr><tr><td>102</td><td>80</td><td>202</td><td>40</td><td>Independent claims in excess of 3</td></tr><tr><td>104</td><td>270</td><td>204</td><td>135</td><td>Multiple dependent claim, if not paid</td></tr><tr><td>109</td><td>80</td><td>209</td><td>40</td><td>** Reissue independent claims over original patent</td></tr><tr><td>110</td><td>18</td><td>210</td><td>9</td><td>** Reissue claims in excess of 20 and over original patent</td></tr><tr><td colspan="4">SUBTOTAL (2)</td><td>(\$1,144.00)</td></tr></tbody></table> **or number previously paid, if greater; For Reissues, see above		Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description	103	18	203	9	Claims in excess of 20	102	80	202	40	Independent claims in excess of 3	104	270	204	135	Multiple dependent claim, if not paid	109	80	209	40	** Reissue independent claims over original patent	110	18	210	9	** Reissue claims in excess of 20 and over original patent	SUBTOTAL (2)				(\$1,144.00)																																																																																																																																																									
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SUBMITTED BY		Complete (if applicable)	
Name (Print/Type)	Marc S. Kaufman	Registration No. (Attorney/Agent)	35,2121
Signature		Telephone	(703) 790-9110
		Date	June 20, 2001

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UNITED STATES PATENT AND TRADEMARK OFFICE



COMMISSIONER FOR PATENTS
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WASHINGTON, D.C. 20231
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APPLICATION NUMBER	FILING/RECEIPT DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NUMBER
09/811,769	03/20/2001	Robert S. Oscar	746829-5

CONFIRMATION NO. 9298

22204
NIXON PEABODY, LLP
8180 GREENSBORO DRIVE
SUITE 800
MCLEAN, VA 22102

FORMALITIES LETTER



OC00000006000434

Date Mailed: 04/24/2001

NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

06/21/2001 ETULU1 00000002 09811769

01 FC:101	710.00 OP
02 FC:103	504.00 OP
03 FC:102	640.00 OP
04 FC:105	130.00 OP

FILED UNDER 37 CFR 1.53(b)

Filing Date Granted

An application number and filing date have been accorded to this application. The item(s) indicated below, however, are missing. Applicant is given **TWO MONTHS** from the date of this Notice within which to file all required items and pay any fees required below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

- The statutory basic filing fee is missing.
Applicant must submit \$ 710 to complete the basic filing fee and/or file a small entity statement claiming such status (37 CFR 1.27).
- Total additional claim fee(s) for this application is \$822.
 - \$342 for 19 total claims over 20.
 - \$480 for 6 independent claims over 3 .
- The oath or declaration is missing.
A properly signed oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date, is required.
- To avoid abandonment, a late filing fee or oath or declaration surcharge as set forth in 37 CFR 1.16(e) of \$130 for a non-small entity, must be submitted with the missing items identified in this letter.
- **The balance due by applicant is \$ 1662.**

The application is informal since it does not comply with the regulations for the reason(s) indicated below.

The required item(s) identified below must be timely submitted to avoid abandonment:

- Substitute drawings in compliance with 37 CFR 1.84 because:
 - drawing sheets do not have the appropriate margin(s) (see 37 CFR 1.84(g)). Each sheet must include a top margin of at least 2.5 cm. (1 inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 1.5 cm. (5/8 inch), and a bottom margin of at least 1.0 cm. (3/8 inch);

Repln. Ref: 06/21/2001 ETULU1 0010120000
DAH:192380 Name/Number:09811769
FC: 704 \$40.00 CR

A copy of this notice MUST be returned with the reply.

A handwritten signature, possibly "M", enclosed in a circle, positioned above a horizontal line.

Customer Service Center

Initial Patent Examination Division (703) 308-1202

PART 2 - COPY TO BE RETURNED WITH RESPONSE